

The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

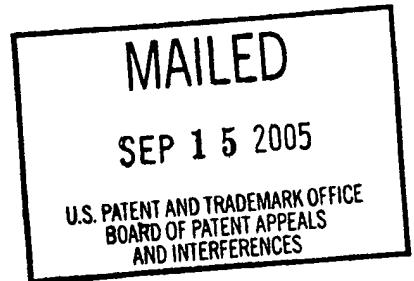
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY YOUNG HOBBS and JOHN FREDERICK GRAF

Appeal No. 2005-2405
Application No. 09/547,243

ON BRIEF



Before JERRY SMITH, BLANKENSHIP, and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 72. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 72.

THE INVENTION

The invention relates to a computer implemented method for enabling design of a product having a visual effect caused by an additive which includes obtaining information relating to the additive and providing a representation of the product having the visual effect based on the information relating to the additive. See page 2 of appellants' specification.

Claim 1 is representative of the invention and is reproduced below:

1. A computer-implemented method for enabling design of a product having a visual effect caused by an additive, the method comprising:
obtaining information relating to the additive; and
providing a representation of the product having the visual effect based on the information relating to the additive.

THE REFERENCES

The references relied upon by the examiner are:

Pringle 6,166,814 Dec. 26, 2000
 (filed Sep. 30, 1998)

McKay et al. 5,593,773 Jan. 14, 1997

Computer Images (Understanding Computers series), by Time-Life Books, 1986, Pages 34, 35, 68, 69, 78, 79,¹ 80 and 102.

Communications (Understanding Computers series), by Time-Life Books, 1986, pages 66 and 67.

Computer Security (Understanding Computers series) by Time-Life Books, 1986, pages 76, 77.

¹ The copy of pages 78 and 79 of this document, which are made of record, are unintelligible. Accordingly, we have not considered the teachings of pages 78 and 79 in reaching our decision. Additionally, we note the examiner does not rely upon these pages for the rejection of any of the independent claims.

THE REJECTIONS AT ISSUE

Claim 1 stands rejected under 35 U.S.C. § 103 as being obvious over Pringle in view of Computer Images. Claims 2 through 11 and 49 through 59 stand rejected under 35 U.S.C. § 103 as being obvious over Pringle in view of Computer Images, McKay and Computer Security. Claims 12 and 25 stand rejected under 35 U.S.C. § 103 as being obvious over Pringle in view of Computer Images and Communications. Claims 13 through 24, 26 through 48 and 60 through 72 stand rejected under 35 U.S.C. § 103 as being obvious over Pringle in view of Computer Images, Communications, McKay and Computer Security.

Throughout the opinion we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejections of claims 1 through 72 under 35 U.S.C. § 103.

On pages 9 and 10 of the brief, appellants argue that the combination of the references do not teach the feature of providing a representation of a product having a visual effect based upon the information related to the additive. On page 11 of the brief, appellants argue, "the Examiner's rationale for combining the references appears to be based on potential advantages hypothesized by the Examiner, not on the teachings in [the] references themselves." Further, the appellants argue:

[I]f one of ordinary skill in the art were to combine the teachings of Pringle with those of the Computer Images reference, Appellants submit that the combination would not yield the subject matter recited in independent claim 1. As noted above, the Pringle reference simply discloses a method for characterizing a coating having a pigment and metallic flakes. See Pringle, col., lines 11-15. In the reference, the paint has metallic flakes and is subjected to one or more beams of light to determine the ratio of pigment absorption to pigment scattering, K/S. See *id.* at col. 3, line 43 - col. 4, line 20. Accordingly, the Pringle reference simply determines the characteristics of paint having a pigment and metallic flakes. Further, the Computer Images reference simply describes how ray tracing may be utilized to imitate the play of light on a scene. See *id.* p. 68.

Thus, at best, the combination would yield a method that allows one to create images of the characterization performed in the Pringle reference. The method would not allow one to design a product having a visual effect caused by an additive, as recited in the present claim.

Clearly the proposed combination does not contemplate the capability of allowing one to design a product having a visual effect caused by an additive. Accordingly, because no teaching or suggestion supporting the combination is present, the Examiner's proposed combination is unsupported speculation and therefore is not proper.

In response the examiner states, on page 14 of the answer, that appellants' assertions are contrary to the written record, stating:

The Examiner's motivational statement is thoroughly and explicitly supported by the prior art:

"At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to use Computer Images to modify Pringle. One of ordinary skill in the art would have been motivated to do this to achieve "enormous gains in productivity" (per Computer Images page 102) by reducing the number of "trial" coatings (per Pringle column 2, line 23) required to obtain the desired product."

We disagree with the examiner's rationale. The examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). It is the burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by the implication contained in such teachings or suggestions. *In re Sernaker* 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Huston* 308

F.3d 1267, 1278, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab* 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 2000)).

The examiner states, on page 4 of the answer, that Pringle does not teach the limitation of “providing a representation of the product having the visual effect based on the information relating to the additive.”² While we speculate that these steps appear to describe the common feature of car manufacturers’ web sites, which allow visitors to view cars with different paint options, no evidence is before us as to how such web sites operate and we leave it to the examiner to find and consider such evidence. Nonetheless, the examiner asserts that Computer Images provides a teaching of this limitation. While we concur that Computer Images provides several teachings directed to producing computer generated images, we do not find that the sections cited by the examiner provide motivation to modify Pringle to provide a representation of the product having the visual effect.

² On page 5 of the answer, the examiner finds the scope of the term “visual effect” to be “any change in the vision (or appearance) of an object that is produced by an agent.” Appellants, on page 7 of the brief take objection to this interpretation of the term visual effect and assert that visual effect is defined in the specification “to include ‘speckled, metallic, pearlescence, fluorescence, angular metamerism (e.g. the phenomenon where two colors appear to match under one light source, yet do not match under a different light source), granite, stone, brick and the like appearances, as well as a translucent capability, and combinations thereof.’” We agree with the examiner’s interpretation of the claim limitation and find that the appellants’ asserted definition is not a definition but a list. Appellants’ list does not clearly give notice as to what is included and excluded as a visual appearance; rather the list merely provides examples. Additionally, we note that the interpretation asserted by the examiner is consistent with appellants’ disclosure in that it includes all of the examples set forth in the appellants’ list.

As appellants argue, we find that Pringle is directed to a method of monitoring and characterizing a coating with a pigment with metallic flakes, this method being used in conjunction with color matching paints. See abstract and title of Pringle. The invention characterizes the pigment by K, the cross-section of the pigment multiplied by the volume concentration and the S, the scattering cross-section of the pigment. We find no suggestion in Pringle that this information is to be used to produce a computer generated image such as discussed in Computer Images. Similarly, while we concur with the examiner that page 68 of Computer Images teaches a method of using computer graphics to mimic reality, and that page 102 of Computer Images teaches that that computer aided drafting, engineering and manufacturing will produce gains in productivity, we find no teaching in Computer Images that the method should be used in conjunction with a method for monitoring and characterizing a coating with a pigment and metallic flakes such as taught by Pringle. Nor do we find that the nature of the problem to be solved by either reference provides suggestion or motivation to combine the references in the manner asserted by the examiner. Pringle is concerned with paint matching, and Computer Images is concerned with improving computer graphics and using computer graphics to enhance productivity in design and manufacturing. Accordingly, we will not sustain the examiner's rejection of claim 1.

We next consider the examiner's rejections of claims 2 through 72. Independent claims 12, 25, 36, 49 and 60 all contain a limitation of providing a representation of the product having the visual effect based on the information relating to the additive, similar to that discussed *supra* with respect to claim 1. These claims are all rejected over Pringle and Computer Images with various combinations of Computer Security, McKay, and Communications. The examiner does not assert, nor do we find, that McKay or Computer Security or Communications teach or suggest modifying Pringle to include the limitation of providing a representation of the product having the visual effect based on the information relating to the additive. Accordingly we will not sustain the examiner's rejection of claims 2 through 72 for the reasons discussed *supra* with respect to claim 1.

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In summary we will not sustain the examiner's rejection of claims 1 through 72.

REVERSED



JERRY SMITH
Administrative Patent Judge)



HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

) BOARD OF PATENT
APPEALS AND
INTERFERENCES



ROBERT E. NAPPI)
Administrative Patent Judge)

REN/vsh

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